



Sughrue, Mion, Zinn, Macpeak & Seas, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202

In re Application of RICHARDS et al
U.S. Application No.: 09/647,098
Int. Application No.: PCT/AU99/00232
Int. Filing Date: 30 March 1999
Priority Date: 30 March 1998
Attorney Docket No.: Q-60901
For: VACCINATION MODALITIES

1
DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is in response to applicants' "Petition Under 37 C.F.R. § 1.47(a)" filed 02 May 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the three joint inventors.

BACKGROUND

On 30 March 1999, applicants filed international application PCT/AU99/00232, which claimed priority of an earlier Australia application filed 30 March 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 07 October 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 18 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 September 2000.

On 26 September 2000, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 02 November 2000, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 02 May 2001, applicants filed the present petition along with the appropriate extension of time fee. The petition states that inventor Norman Stewart refuses to join in the application.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration executed by inventors David Richards and Wayne Jorgensen each on his own behalf and on behalf of inventor Stewart.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a copy of the application papers (including specification, claims, drawings, and oath or declaration) to Dr. Stewart for signature. The petition states that declaration and assignment forms were sent to Mr. Tinworth (see affidavit of Peter Stearne, paragraphs 12-13, and Exhibits PAS-9/10). However, no evidence has been provided which indicates that a copy of the application papers (including specification, claims, drawings, and oath or declaration) was ever sent to Dr. Stewart for signature. Because applicants have not established that a bona fide attempt was made to present a copy of the application papers to Dr. Stewart for signature, it would not be reasonable to conclude at the present time that Dr. Stewart refuses to join in the application.

With regard to item (3) above, applicants have provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Bryan Tung
Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459